



Doc Code: AP.PRE.REQ

PTO/SB/33 (07/05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

891.0002.U1(US)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR

on May 2, 2007

Signature *Debra Pongetti*

Typed or printed name Debra Pongetti

Application Number

10/769,378

Filed

01/30/2004

First Named Inventor

Jeanet Harvej

Art Unit

2617

Examiner

Holliday, Jaime M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,304

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

David M. O'Neill (35,304)
Signature

David M. O'Neill

Typed or printed name

(203) 925-9400

Telephone number

May 2, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Atty. Docket:

Harvej *et al.*

891.0002.U1(US)

Serial No.: 10/769,378

Art Unit: 2617

Filed: January 30, 2004

Examiner: Holliday, Jaime Michele

Customer No.: 29683

Confirmation No.: 7896

Title: Tune Cutting Feature

PRE-APPEAL BRIEF REQUEST FOR REVIEW ATTACHMENT

The following is a concise recitation of clear error in the Examiner's rejections in this application.

1. In the Final Office Action of November 2, 2006 (hereinafter "the November 2 Final Office Action"), the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,496,692 to Shanahan (hereinafter "Shanahan" or "the Shanahan patent") in view of United States Patent Application Publication No. US 2003/0083107 A1 to Morishima (hereinafter "Morishima" or "the Morishima application").

Claim 5 recites, in part, "means for allowing the user to select part of the audio information, the means comprising a display for showing audio information available for selection and a cursor, the cursor for selecting a part of the audio information". FIG. 7 of Morishima does not show a cursor being used to "select *part* of the audio information". Rather, FIG. 7 and the accompanying description of Morishima show alternate melodies being selected. The alternate melodies are not described as being part of anything greater; rather, they are described as separate entities that are

alternatives and selected as such. This is apparent from paragraphs 54 – 56 of Morishima reproduced here (emphasis added):

“On the other hand, in a case where a short cut function for changing the ring tone or the color of light of the LED for indicating an incoming call is registered in the storage unit 15 as a setting of an operation by use of the sub-operation unit 10, the control unit 14 causes the sub-display unit 8 to display a select screen corresponding to the registered short cut function (Step S3). Here, a setting function for the ring tone is registered. Accordingly, the control unit 14 causes the sub-display unit 8 to display a select screen for selecting ‘Melody 1’ or ‘Melody 2’ as shown in the display screen 40 in FIG. 7, for example.

Next, in a case where the number of the registered sounds or melodies which can be set is more than one, the user can scroll the screen by pushing the second operation key 12 or the third operation key 13 of the sub-operation unit 10 to display a select screen for selecting ‘Tone 4’ or ‘Melody 3’ as shown in a display screen 30 or 50 in FIG. 7, for example.

If the user pushes the first operation key 11 in a state where a cursor (square portion on the display screens 30 to 50 in FIG. 7) is positioned to a desired sound or melody, the control unit 14 determines a setting of the ring tone which is designated by the cursor.”

Notably absent from this portion, or any other portion, of Morishima, is either a description or a suggestion that a part of a melody or ring tone be selected with a cursor.

In other words, Shanahan teaches that parts of audio selections can be edited to be used as, for example, a ring tone, but says nothing about the use of a cursor to perform such editing functions. Morishima teaches that a cursor can be used to select

alternate melodies to function as a ring tone, but does not teach using a cursor to perform an editing function by “selecting a *part* of the displayed audio information” with the cursor. Accordingly, the combination of Shanahan and Morishima as a matter of common sense neither describes nor suggests the relevant subject matter of claim 5.

Accordingly, Applicants respectfully submit that claim 5 is patentable over any of the art of record, whether taken singly or in combination. Applicants therefore respectfully request that the rejection of claim 5 be withdrawn.

2. In the November 2 Final Office Action, the Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over the Shanahan patent in view of United States Patent No. 6,771,982 B1 to Toupin (hereinafter “Toupin” or “the Toupin patent”).

Claim 15 recites “means for *depicting* how much memory remains for storing an audio signal, wherein the memory remaining is represented by a time duration.” It is not seen how the Toupin patent, which is devoid of any instrumentality for depicting anything, either describes or suggests “means for *depicting* how much memory remains”. At column 2, lines 18 – 20. Toupin states (emphasis added):

“In the present invention, the user of a telecommunication device is presented with an action, an option, or a series of options via audio messages.”

At column 18, lines 55 - 65, Toupin states (emphasis added):

“The Getting Status Information option allows the user to get status information about the companion telecommunicator. The user places the companion telecommunicator in Whisper or Speaking Mode. The user squeezes when the user hears: ‘Provide Status Information.’ The companion telecommunicator announces the telephone number and time and date and tells the user if the user has messages waiting, then reports current battery level, signal strength, roaming status, memory available in minutes and second, the current billing rate, and balance remaining on card (optional). The user squeezes to advance to the next report.”

As is apparent, the memory remaining is not depicted in the method of Toupin but is audibly announced. This emphasis on communicating information aurally in Toupin is not surprising since Toupin states at page 2, line 56 – 65 (emphasis added):

“This interface protocol permits functional manipulation of complex devices, such as personal telecommunication devices without the necessity of the visual feedback via textual or graphic data. Since the sensor functions change with time rather than placement, both visual and tactile demands placed upon the user are dramatically reduced, offering an advantage over the complex array of graphic symbols and the symbolic placement of buttons found on multifunction keypads.”

In view of the foregoing, it is not seen how the Toupin patent could possibly either describe or suggest a method for depicting information, when Toupin is particularly concerned with avoiding display of graphical symbols and graphical controls for performing control operations. Accordingly, Applicants respectfully submit that claim 15 is patentable over any of the art of record, whether taken singly or in combination. Applicants therefore request that the rejection of claim 15 be withdrawn.